

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	P. Hamilton Clark et al.)	Examiner:
)	Johnna R. Loftis
Serial No.	:	09/950,087)	
)	Art Unit:
Cnfrm. No.	:	2257)	3624
)	
Filed	:	September 10, 2001)	
)	
For	:	ELECTRONIC PROJECT MANAGEMENT)	
		SYSTEM USING PROJECT PHASES)	
)	

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants respectfully submit this Reply Brief in response to the Examiner's Answer, mailed on December 15, 2008.

Before proceeding with a detailed analysis of the new points raised in the Answer, Appellants again would like to point out that dependent claims 3, 5, 15 and 17 include the terms "enabling" and "the enabling," which do not have explicit antecedent basis in the independent claims 1 and 13, from which they depend. These terms in claims 3, 5, 15 and 17 should have been replaced with "advancing" and "the advancing" to conform with the change of the term "enabling" with the term "advancing" in the Amendment dated February 1, 2006, in independent claims 1 and 13. It is believed this is a minor inadvertent oversight that can be addressed by way of an Examiner's Amendment or an amendment by Appellants after decision by the Board.

Supplemental Arguments

In the “New Grounds of Rejection” section (section (9) of the Examiner’s Answer, starting on page 5), several newly presented points were raised and are now addressed.

On page 5, for the first time the Examiner rejects claims 1-6 and 19-22 under 35 U.S.C. § 101. The Examiner asserts that the recited method steps are mere mental steps and therefore fail to qualify as a § 101 statutory process. Appellants respectfully disagree. As evidenced, for example, elements 16 and 22 of FIG. 2 and in at least paragraphs [0038] to [0042] of the published application, the various recitations of “one or more stored exit criteria” in both claims 1 and claim 19 clearly are not “mental steps” as asserted by the Examiner and outlined in § 101. Clearly, a device/server with memory is needed to store the one or more exit criteria, as claimed and disclosed throughout the application. Thus, Appellants contend that claims 1-6 and 19-22 are indeed statutory. Therefore, Appellants respectfully request that the Section 101 rejection be withdrawn.

Further, the Examiner refers to partial data structures shown in Table 1 (see, col. 7), and a description in col., 8, ll. 38-44 of assigning an unique sequence or identification number to each goal in a template, and that the goal information is retrieved as necessary from the goal database during the processing of a WIP (work in process). The Examiner asserts, “Since each goal, reflecting criteria that must be met prior to moving to the next task, is entered, stored and later retrieved when executing a workflow (see col. 9, ll. 21-66), the user is accessing ‘stored exit criteria,’ or goal data, that must be accomplished prior to completion.”

In other words, it appears the Examiner considers that during the execution of a computer program (*i.e.*, an SWA and/or CMA) carrying out a WIP, the user causing execution would be meeting claimed features relating to identifying which of one or more stored exit criteria are applicable to at least one of the phases of the project and establishing the identified one or more exit criteria for the at least one phase. This contention is different from what is set forth in the rejections, where the Examiner had asserted that the designer identifies and establishes criteria when conceptualizing a WIP and its related goals/tasks.

However, it should first be noted that the claimed features of identifying and establishing are performed at the front end of the method of managing a project. While McAtee et al. describes a designer conceptualizing WIP goals, and establishing them into the workflow by way of entering them into a workflow template by way of an editing interface

(i.e., a “Manager Utility” (M/U)) to “generate a database of workflow descriptions that includes goals, relationships among goals and characteristics associated with each goal” (see, col. 6, ll. 1-67), McAtee et al. includes no description whatsoever that the designer identifies which exit criteria are applicable to any particular goal from among stored exit criteria, as claimed, even if one were to broadly assume that a WIP and its “workflow” (defined in col. 1, ll. 30-31 as “a path followed by a WIP”) correspond to the claimed “project,” a “goal” corresponds to the claimed “phase of the project” and other “goals” and/or “tasks” used to carry out a phase of the project correspond to “exit criteria.” Rather, McAtee et al. describes a designer who determines goals and their relations to one another by entering data into the M/U, which creates a table called a “workflow definition database” (see, col. 6, ll. 7-13). In fact, McAtee et al. explicitly states:

In operation, the M/U performs in a manner analogous both to word-processing and graphical editors, the designer establishes a workflow definition, against which work is ultimately processed, and sets system parameters. The M/U allows the designer to define the manner in which WIPs are created and identified, as well as the manner in which they will be used to control the workflow operation. (Emphasis added.) (See, col. 3, line 64 to col. 4, line 3.)

Because the McAtee et al. system involves a designer who conceptualizes a business process and established them by entering the goals and/or tasks into fields of a Manager Utility (M/U) to create a workflow template, and the designer appears to identifying goals/tasks on the fly, McAtee et al. fails to describe the identification of which of one or more stored exit criteria are applicable to at least one of the phases of the project and the establishment of the identified one or more exit criteria for the at least one phase (i.e., the identified exit criteria recited in the previous limitation), as set forth in Appellants’ independent claims. Hence, it cannot be said that McAtee et al. anticipates the pending independent claims.

To establish anticipation under 35 U.S.C. § 102(b), the Examiner must show that each and every feature recited in these claims is either explicitly disclosed or “necessarily present” in a single prior art reference, such as within the four corners of the McAtee et al. patent. *See* M.P.E.P. § 2131(7th ed. 1998); *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). To support a conclusion of anticipation, the Examiner must specifically identify “substantial evidence” setting forth why and how the single prior art reference anticipates each and every feature recited in the claims. *See In re Mullin*, 481 F.2d 1333, 1336-37 (CCPA 1973) (An

Examiner's bare assertion that claims were obviously anticipated by a reference did not inform the Applicant as to why the claims lacked novelty); *Dickinson v. Zurko*, 527, U.S. 150 (1999) (The U.S. Patent Office's findings of fact must be reviewed by the substantial evidence standard).

Viewed against this backdrop, each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less to 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b). In this case, however, the Examiner cannot satisfy his burden of demonstrating how McAtee et al., taken alone or in combination with any other prior art reference, can either render obvious each and every one of the limitations present in independent claims 1, 6, 11, and 16 as required by the Manual of Patent Examining Procedure ("MPEP") and Federal Circuit jurisprudence.

Returning now to the newest citations from McAtee et al., the Examiner appears to consider the McAtee et al. description in cols. 7-9 of executing a computer program that retrieves goals/tasks from a database by way of an identification sequence or number as for meeting the claimed features of identifying which of one or more stored exit criteria are applicable to at least one of the phases of the project. However, the Examiner is placing the cart before the horse with respect to the appealed claims because "goals" in McAtee et al. are established by the designer at the front end, and not during execution of the program carrying out the WIP. Moreover, the established goal/tasks in McAtee et al. were not ones identified as applicable from stored exit criteria, as claimed.

In contrast, Appellants' independent claims recite, among other things, a feature of identifying something, and a feature of establishing that identified thing, and therefore defines a specific order in which these features are performed. More specifically, the claims recite that an identification is made as to which of one or more stored exit criteria are applicable to at least one of the phases of the project, and that the same exit criteria identified previously are established for the at least one phase. As described, for example, in paragraphs [0038] to [0042] spanning pages 12 to 13, recommended exit criteria for each of the project phases may have already been created and stored in memory of a project server and activities. The identifying of the one or more exit criteria for a phase may involve

selecting from these stored criteria, and establishing of the identified exit criteria may or may not involve additional processes, for example, modifying or approving the criteria.

By contrast, the McAtee et al. patent describes a designer establishing goals and tasks at the front end without identifying them from stored exit criteria, and the later processes of creating programs to carry these same established goals and tasks out cannot reasonably be considered both an identification, and thereafter, establishment of these tasks and goals. Thus, the McAtee et al. patent fails to describe these features as set forth in the appealed independent claims with respect to “identifying” and “establishing” “exit criteria.” Accordingly, McAtee et al. cannot anticipate these claims and the claims depending therefrom within the purview of Section 102.

For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claims are not found either expressly or inherently described as required by the M.P.E.P., McAtee et al. cannot be said to anticipate the invention as claimed.

For at least these reasons, and the reasons pointed out in Appellants’ Brief, the appealed rejections should be reversed, and such reversal is respectfully sought.

Respectfully submitted,

Date: February 17, 2009

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